

## REMARKS

Claims 1, 2, 4, 5, 7, 8, 11-23 and 26-28 were pending prior to this amendment. Claims 1, 2, 11, 12, 16, 17, 26, and 28 are allowed. Claims 4, 5, 7, 8, 12-15 and 18-23 were rejected. Claims 4, 7, and 12 have been amended. Claims 15, 21, 23, and 27 have been cancelled. Applicant requests reconsideration and allowance of the application.

### Allowed claims

Claims 1, 2, 11, 12, 16, 17, 26, and 28 are allowed. Although the applicant's attorney agrees with the Examiner's conclusion that these claims are allowable, the applicant's attorney notes that the claims may be allowable for reasons other than those identified by the Examiner and does not concede that the Examiner's characterizations of the terms of the claims and the prior art are correct.

Regarding allowed claim 12, Applicant notes that the Office Action rejected allowed claim 12 based on 35 U.S.C. § 103 (claim 12 was indicated as both allowed and rejected per the Office Action summary on page 2 of the Office Action). As will be explained later in greater detail, although Applicant does not concede any basis for rejecting allowed claim 12, in the interest of expediting prosecution claim 12 has been amended.

### Claim Rejections - 35 U.S.C. § 112

Claims 15, 21, and 23 were rejected under 35 U.S.C. § 112, first paragraph, based on written description and enablement.

Applicant discloses sensing vibration in any direction in at least FIG. 4, block 402, and discloses compensating for the same in at least FIGS. 4 and 5, blocks 404, 408, and 414. Thus, the features of claims 15, 21, and 23 are disclosed and do not constitute new matter.

Regarding the enablement rejection of claims 15, 21, and 23, this rejection is improper for at least the reason that the Office has not met its initial burden for establishing an enablement rejection. The standard for enablement is whether undue experimentation is needed to practice the claimed invention. See MPEP 2164.01 citing *In re Wands*, 8 USPQ2d 1400, 1404. The Examiner must determine the question of law based on factual findings and “should **never** make the determination based on personal opinion.” MPEP 2164.05. Here, the Office Action jumps to

a legal determination without making any factual findings supporting the legal determination. For example, although the Office Action lists some Wands factors that allegedly support a legal determination of non-enablement, the Office Action does not provide any factual findings indicating why the Examiner believes that the listed factors support non-enablement instead of enablement. Moreover, the Examiner's personal opinion that "it is infinitely harder to optically correct an image for vibration in each of the X, Y, and Z directions at the same time" does not appear to be based on any evidence and therefore is not a factual finding. Accordingly, since the Office Action makes a legal determination unsupported by any factual findings, the Office has not met its initial burden of establishing an enablement rejection.

However, despite the rejections to claims 15, 21, and 23 being improper for at least the reasons explained above, in the interest of expediting prosecution Applicant has cancelled claims 15, 21, and 23.

Claim 27 was rejected under 35 U.S.C. § 112, first paragraph, based on written description.

Applicant does not concede any basis for the written description rejection of claim 27. However, in the interest of expediting prosecution, claim 27 has been cancelled.

### **Claim Rejections - 35 U.S.C. § 103**

Claims 4, 5, 7, 8, 12-14, 18-20, and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paltz, *et al.*, (European Publ. No. 0003243 A1) in view of Misawa, *et al.*, (U.S. Patent No. 5,041,852) and further in view of Ariga, *et al.*, (U.S. Patent No. 5,933,191).

Claim 7 recites "means for sensing a vibration of the light sensing device of the apparatus; means for converting said vibration to an actuator signal; and means for adjusting an optical assembly of the apparatus according to the actuator signal." None of the cited art discloses these features.

Misawa discloses a camera shake correction system that corrects for a camera being shaken. *See* abstract. The system detects shaking by measuring the angular speed of the camera as a whole. Measuring the angular speed of the camera as a whole is not sensing "a vibration of the light sensing device of an apparatus" because any light sensing devices inside the camera can

vibrate at least partially independently of the movement of the camera, which is not necessarily detected by measuring the angular speed of the camera as a whole.

In contrast, claim 7 recites the features of “means for sensing a vibration *of the light sensing device of the apparatus*; means for converting *said vibration* to an actuator signal; and means for adjusting an optical assembly of the apparatus *according to the actuator signal*.” Thus, claim 7 should be allowed.

Regardless of the above, in the interest of expediting prosecution, claim 7 has been amended. Given the Examiner’s reasons for allowing claim 1, it is believed amended claim 7 is allowable for similar reasons that claim 1 was allowed. Accordingly, Applicant requests that the Examiner enter the amendments shown to claim 7 pursuant to MPEP 714.12 on the basis that these amendments put the present application in a condition for allowance.

Although the rejections to claims 4 and 12 are improper for similar reasons as stated above, in the interest of furthering prosecution, claims 4 and 12 have also been amended as shown above. Applicant requests that the Examiner enter the amendments shown to these claims pursuant to MPEP 714.12 on the basis that these amendments put the present application in a condition for allowance. Claims 5, 8, 13, 14, 18-20, and 22, being dependent, include the same features as their respective base claims and thus should be allowed for at least the same reasons.

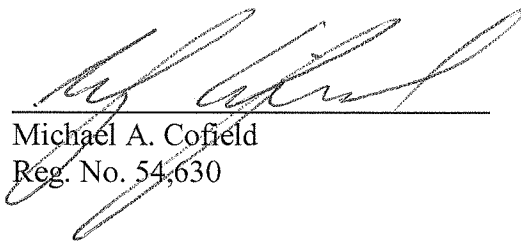
### **Conclusion**

For the foregoing reasons, reconsideration and allowance of the application as amended is requested. The examiner is encouraged to telephone the undersigned at (503) 224-2170 if it appears that an interview would be helpful in advancing the case.

**Customer No. 73552**

Respectfully submitted,

STOLOWITZ FORD COWGER LLP



Michael A. Cofield  
Reg. No. 54,630

STOLOWITZ FORD COWGER LLP  
621 SW Morrison Street, Suite 600  
Portland, OR 97205  
(503) 224-2170